

REMARKS

In the Specification

None.

Rejections Under 35 USC 101

5 Claims 1-14 stand rejected under 35 USC 101 as being directed to non-statutory subject matter and not limited to practical applications as determined by the Examiner's interpretation of the statute and *In re Warmerdam* (1994) clarified by *AT&T Corp. v. Excel Communications, Inc.* (1995).

10 With respect to Examiner's allegation that the present invention is directed to non-statutory subject matter, is not limited to practical applications in the technological arts, Examiner has failed to view the application as now required under *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005). On appeal, the board limited its consideration to the single issue of whether the examiner's rejection of certain claims under §101 should be sustained. In an action by the Patent Office leading to the appeal, the examiner had rejected certain claims as being
15 directed to "nothing more than an abstract idea which is not associated or connected to any technological art." Accordingly, the board considered the examiner's argument that the claims were "outside the technical arts" because they were related to "an economic theory expressed as a mathematical algorithm without the disclosure or suggestion of a computer, automated means, or an apparatus of any kind."

20 In support of the technological arts test, the examiner cited several decisions by the Court of Customs and Patent Appeals (the judicial body that preceded the U.S. Court of Appeals for the Federal Circuit) and the board. These included *In re Musgrave*, 431 F2d 882, 167 USPQ 280 (CCPA 1970); *In re Toma*, 575 F2d 872, 197 USPQ 852 (CCPA 1978); and *Ex parte Bowman*,

61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001) (nonprecedential). A majority of the board found that the foregoing decisions either did not support the existence of a separate “technological arts” test, or were non-precedential and therefore non-binding. Accordingly, the majority opinion in *Ex parte Lundgren* concluded that “there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under §101,” and on that basis reversed the examiner’s rejection.

In the present application Examiner has similarly stated “Applicant’s ‘information from a respondent or other external source’ references are just such abstract ideas.”¹ In response Applicant argues that under *Lundgren* this rejection is improper and respectfully requests withdraw of this rejection. Applicant has also amended claim 1 to deleted the phrase “from a respondent or other external source” so now that claim element reads “a software program capable of adaptive assessment administration via a web browser or computer terminal with the ability to accept survey or assessment related information” which is actual, concrete information and not abstract ideas or information as interpreted by the Examiner.

Furthermore, Examiners are now bound by the *Ex parte Lundgren* decision and the Patent Office can no longer apply a “technological arts” test for statutory subject matter rejections. Examiner’s statement in paragraph 3 of the office action that the set of precedents provided by *In re Warmerdam* and *AT&T v. Excel* are within the same line of cases as *State Street* is incomplete and does not take into account *Lundgren*’s effect on those previously decided cases and its expansion of 35 USC 101 after the *State Street* Decision. The Patent Office has since promulgated interim guidelines reflecting the *Ex Parte Lundgren* decision. The guidelines explain that subject matter may be eligible for patent protection even if the claimed invention

¹ Page 2, paragraph 2 of the Office Action mailed 05/03/2006.

falls within one of the judicial exceptions to §101 (an abstract idea, law of nature, or natural phenomenon).

Under such circumstances, however, the guidelines require that the claimed invention be a “practical application” of one of the exceptions, which requirement may be met “if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.” In the present invention the process of adaptive assessments produces useful information that is both concrete and tangible in the form of reports that provide probability and statistical information as illustrated in Figures 7, 8 and 9 of the present application.

One example of practical use is taken from the Summary section of the present application related to personality inventories and an attempt to classify individuals into personality types or categories based on their responses to items. By specifying the relationship between these items and personality types, a probability matrix can be created and used as a basis for adaptive administration and potentially reduce the number of items needed for administration. In addition, other areas such as diagnosing illnesses based on patients' symptoms can be helped by using this methodology if the presence of symptoms can help classify illness into distinct categories.

With respect to Examiner’s position that Applicant cites no specific results to define a useful, concrete, and tangible result, Examiner is direct to Figures, 7, 8, and 9 of the application which are screen shots of the output of the software which embodies the process of the present invention and provides actual results of information collected and analyzed according the process of the present invention. The probability updates in response to the changing information in the database provide useful information to one seeking the most likely results form a series of

options such as occupational classification. The associated practical application of just one embodiment of the present invention is that the concrete tangible results delivered by the software and illustrated in the Figures can help one determine the most suitable occupation or the most successful career path. Examiner should also note the specification and claims discuss other alternative embodiments where similar useful, concrete, tangible output as represented by Figures 7, 8, and 9 can be used includes other such practical purposes such as market performance, quantification of an individual's skill set, evaluation of educational instructors, courses, and institutions, assisting in troubleshooting and solving technical and complex issues among many other possible applications.

With respect to Examiner's allegation that Applicant is merely manipulating a set of abstract information to solve a purely algorithmic problem is incorrect. The kind of information necessary for the process to proceed, must be concrete. Depending on the assessment desired, the "information" can be in many forms, but all of it must be concrete and tangible or indexed. For example, to provide an assessment of an election the information would include such tangible information as number of collection locations, polling surveys of public opinion of topics, a source of census data and public opinion, interest, value, or intention information. For assessing marketability of a product, such tangible information as the number of potential customers and competitors can be provided in addition to specific information provided from market research, employees, vendors, and resellers.

Applicant in its initial claims did provide limitations on the information equivalent to the of monetary data or heart rhythm as cited by the examiner. The specific information that can be used is discuss in the application and was provided in claims focusing on a specific assessment area. The claims do much more than manipulate abstract ideas as alleged by the Examiner, the

claims take concrete and tangible information and manipulate it following the process steps disclosed and claimed in such a manner that it provides a useful, concrete, and tangible result in the form of probability updates on potential outcomes or options for a given situation. Applicant would be more than happy to discuss more appropriate claim language to better define and limit the “information” used by the present invention. Withdraw of this rejection is respectfully requested.

Rejections Under 35 USC 112

Claims 1-14 stand rejected under 35 USC 112 by the Examiner’s assertion that no practical application has been asserted for the invention and has not disclosed how to practice the undisclosed practical application. As previously state, one example of practical use is taken from the Summary section of the present application related to personality inventories and an attempt to classify individuals into personality types or categories based on their responses to items. By specifying the relationship between these items and personality types, a probability matrix can be created and used as a basis for adaptive administration and potentially reduce the number of items needed for administration. In addition, other areas such as diagnosing illnesses based on patients' symptoms can be helped by using this methodology if the presence of symptoms can help classify illness into distinct categories.

With respect to Examiner’s statement that “there is no way Applicant could have disclosed how to practice the undisclosed practical application”, Applicant relies on the previous arguments that the invention has been properly and adequately disclosed and the detailed description and figures sufficiently explain how to practice the invention.


Withdraw of this rejection is respectfully requested.

CONCLUSION

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely.

Respectfully submitted,


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